

REMARKS/ARGUMENTS

1.) Claim Amendments

The Applicants have amended claims 1, 13-18, 33, and 40-46. Claims 11, 12, 38, and 39 have been canceled. Accordingly, claims 1-10, 13-37, and 40-57 are pending in the application. Favorable reconsideration of the application is respectfully requested in view of the foregoing amendments and the following remarks.

2.) Claim Rejections – 35 U.S.C. § 103(a)

In paragraph 2 of the Office Action, the Examiner rejected claims 1-3, 5, 6, 8, 19, 21, 24-26, 28-33, 35-37, 47-51 and 53-55 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger, et al. (US 6,748,217) in view of Feder, et al. (US 6,552,881) and further in view of Rozenfeld, et al. (US 2002/0083429). The Applicants have amended the claims to better distinguish the claimed invention from Hunzinger, Feder and Rozenfeld. The Examiner's consideration of the amended claims is respectfully requested.

The Applicant has amended independent claims 1 and 33 to specifically recite the types of information included in the “combined requirements” of the communication device. Basis for the amendments is found in the originally filed specification in paragraph [0027] on page 9. The combined requirements are recited as including:

- a profile of operating capabilities of the communication device;
- quality of service requirements of a service requested by the communication device;
- connection transport requirements of an application requested by the communication device; and
- user preferences regarding a desired access point, said user preferences including cost, speed, quality, and security associated with the desired access point.

It is noted that Hunzinger discloses obtaining information, but *capabilities* information is not disclosed or suggested. This is an important difference from the claimed invention, which the Examiner has overlooked.

The Examiner notes that Hunzinger does not disclose that the combined requirements include quality of service requirements and connection transport

requirements of a service and application requested by the communication device. The Examiner contends these are shown by Feder. However, Feder only discusses link quality and load levels, not quality of service requirements of a service and connection transport requirements of an application requested by the communication device.

The Examiner also notes that Hunzinger and Feder do not disclose that the access points each have an associated cost and that the selection process is based upon a low cost for using the access point. The Examiner contends this is shown by Rozenfeld. However, Rozenfeld has a phrase discussing sorting by price, but there is no disclosure or suggestion of selecting an access point based on low cost.

The Applicants therefore contend that a prima facie case of obviousness has not been established with respect to independent claims 1 and 33 because several limitations of claims 1 and 33 are not taught or suggested by the combination of references cited by the Examiner. Therefore, the withdrawal of the § 103 rejection and the allowance of claims 1 and 33 are respectfully requested.

Claims 2, 3, 5, 6, 8, 19, 21, 24-26, and 28-32 depend from amended claim 1 and recite further limitations in combination with the novel elements of claim 1. Therefore, the allowance of claims 2, 3, 5, 6, 8, 19, 21, 24-26, and 28-32 is respectfully requested.

Claims 35-37, 47-51 and 53-55 depend from amended claim 33 and recite further limitations in combination with the novel elements of claim 33. Therefore, the allowance of claims 35-37, 47-51 and 53-55 is respectfully requested.

In paragraph 19 of the Office Action, the Examiner rejected claims 4, 7, 9, 20, 22 and 34 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Feder in view of Harris, et al. (US 6,331,972). The Examiner cited Harris for disclosing a method of selecting access points wherein the communication device is located in a personal area network, and the database is in the personal area network.

However, Hunzinger and Feder fail to disclose several claim limitations in base claims 1 and 33, and Harris does not solve this shortcoming. Therefore, the allowance of claims 4, 7, 9, 20, 22 and 34 is respectfully requested.

In paragraph 21 of the Office Action, the Examiner rejected claims 10, 11, 15, 16, 18, 27, 38, 41-44 and 46 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Feder in view of Agre. Claims 11 and 38 have been canceled

because their limitations have been incorporated into base claims 1 and 33, respectively.

Regarding claim 10, the Examiner cited Agre for disclosing a mobile service selection system performed with user interaction. However, Hunzinger and Feder fail to disclose several other claim limitations in base claim 1, and Agre does not solve this shortcoming. Therefore, the allowance of claim 10 is respectfully requested.

Regarding claims 15 and 16, the Examiner cited Agre for disclosing that the requirements of the communication device are based on user preferences listed in those claims. However, Hunzinger and Feder fail to disclose several other claim limitations in base claim 1, and Agre does not solve this shortcoming. Therefore, the allowance of claims 15 and 16 is respectfully requested.

Regarding claim 18, the Examiner cited Agre for disclosing storing preferences in a communication system. However, Hunzinger and Feder fail to disclose several other claim limitations in base claim 1, and Agre does not solve this shortcoming. Therefore, the allowance of claim 18 is respectfully requested.

Regarding claim 27, the Examiner cited Agre for disclosing presenting the recommendation to a user. However, Hunzinger and Feder fail to disclose several other claim limitations in base claim 1, and Agre does not solve this shortcoming. Therefore, the allowance of claim 27 is respectfully requested.

Claims 41-44 and 46 correspond to the claims discussed above. The allowance of claims 41-44 and 46 is respectfully requested for similar reasons.

In paragraph 27 of the Office Action, the Examiner rejected claims 14, 17, 23 and 45 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Feder in view of Agre, and further in view of Harris. The Examiner cited Harris for disclosing user preferences stored on a second communication device within a PAN. However, Hunzinger, Feder, and Agre fail to disclose several other claim limitations in base claims 1 and 33, and Harris does not solve this shortcoming. Therefore, the allowance of claims 14, 17, 23, and 45 is respectfully requested.

In paragraph 29 of the Office Action, the Examiner rejected claims 12, 13, 39 and 40 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Feder in view of Agre, and further in view of Pinard.

Regarding claim 12, the Examiner cited Pinard for disclosing that the requirements of the device are based on service/application requirements of the communication device. However, Hunzinger, Feder, and Agre fail to disclose several other claim limitations in base claim 1, and Pinard does not solve this shortcoming. Therefore, the allowance of claim 12 is respectfully requested.

Regarding claim 13, the Examiner cited Pinard for disclosing the steps of determining, comparing, selecting, mismatch determining, and compromising. However, Hunzinger, Feder, and Agre fail to disclose several other claim limitations in base claim 1, and Pinard does not solve this shortcoming. Therefore, the allowance of claim 13 is respectfully requested.

Claims 39 and 40 correspond to claims 12 and 13 discussed above. The allowance of claims 39 and 40 is respectfully requested for similar reasons.

In paragraph 32 of the Office Action, the Examiner rejected claim 52 under 35 U.S.C. § 103(a) as being unpatentable over Hunzinger in view of Feder in view of Vaara, et al. (US 6,321,083). The Examiner cited Vaara for disclosing that the recommendations include directions to a geographical area which is an intermediate position within communication range of at least two access points, which are to be used simultaneously. However, Hunzinger and Feder fail to disclose several other claim limitations in base claim 33, and Vaara does not solve this shortcoming. Therefore, the allowance of claim 52 is respectfully requested.

In paragraph 33 of the Office Action, the Examiner rejected claims 56 and 57 under 35 U.S.C. § 103(a) as being unpatentable over Grube, et al. (US 5,594,947) in view of Hunzinger in view of Feder. Claims 56 and 57 depend from amended claim 33 and recite further limitations in combination with the novel and unobvious elements of claim 33. Therefore, the allowance of claims 56 and 57 is respectfully requested.

The Applicants further argue that in a rejection under 35 U.S.C. § 103, there must be a suggestion to combine the cited references. When three or more references are cited against a claim, it becomes increasingly unlikely that there is a suggestion to combine all of the references. With combinations of four references, as the Examiner has used in this Office Action, it is extremely unlikely that a person of ordinary skill in the art, faced with the problem that confronted the Applicants, would select just the right

combination of references, and select just the right limitation from each reference to achieve the claimed invention.

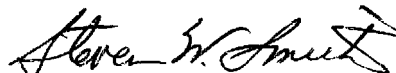
It is much more likely in such a case that the Examiner has selected the various references and limitations using impermissible hindsight gained from reading the Applicants' disclosure. The Applicants contend, therefore, that combinations of three or more references do not establish a prima facie case of obviousness in the absence of express statements of the desirability of making such combinations.

CONCLUSION

In view of the foregoing remarks, the Applicants believe all of the claims currently pending in the Application to be in a condition for allowance. The Applicants, therefore, respectfully request that the Examiner withdraw all rejections and issue a Notice of Allowance for claims 1-10, 13-37, and 40-57.

The Applicants request a telephonic interview if the Examiner has any questions or requires any additional information that would further or expedite the prosecution of the Application.

Respectfully submitted,



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Date: 2-24-2006

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